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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/642,432      | 08/15/2003  | Richard L. Watson    | 80191.00034         | 9875             |

7590 04/05/2005

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| EXAMINER |
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NASSER, ROBERT L

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3736

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                 |  |
|------------------------------|------------------|-----------------|--|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)    |  |
|                              | 10/642,432       | WATSON, RICHARD |  |
|                              | Examiner         | Art Unit        |  |
|                              | Robert L. Nasser | 3736            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35,36,40-43,45,47,48 and 50 is/are rejected.
- 7) ☒ Claim(s) 37-39,44,46 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35, 40-43, 45, 47, 48, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Rawson. Rawson shows an optical strain gauge with a transmitter that is worn on the body to sense body movements. This would indeed include labor contractions. The examiner notes that the language as to sensing uterine contractions is intended use and is not sufficient to define over identical structure intended for used for a different purpose. The examiner notes that the fiber is embedded in a flexible polymer, adhesively attached to a flexible polymer, or connected in a pouch between two sheets of a flexible polymer. Therefore, the bottom sheet has the attachment surface on the bottom and a second surface on the top, which is adjacent the sensor. The second sheet then is a drape or a cover which overlies the sensor. The system of Rawson further has a power source 38 and wireless transmitter 30. With respect to claim 50, the sensor is removable from the device, it that it is capable of being removed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rawson. Rawson teaches that any appropriate means may be used to attach the sensor to the user (see column 8, lines 34-50). The examiner takes official notice that adhesive is an appropriate means.

Claims 37-39, 44, 46, and 49 are objected to as being dependent upon a rejected base claim, but would be if the claims were rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 37 and 39 define over the art in that none of the art shows a generally elliptical sensor. The examiner notes that applicant makes the sensor elliptical to better conform to the abdomen. Hence, it is more than mere design choice and there is no teaching or suggestion to make the sensor of Rawson generally elliptical. Claim 38 defines over the art in that none of the art has a plurality of surface portions with different shapes, as claimed. Claim 44 defines over the art in that none of the art uses multiple fibers, as claimed. Claim 46 defines over the art of record in that none of the art shows the electronics box in a compartment between the two surfaces of the adhesive pad, as claimed. Claim 49 defines over the art in that none of the art has the electronics box in the pouch, as claimed.

Applicant's arguments filed 9/15/2004 have been considered, but are not deemed to be persuasive.

Applicant has asserted that the Rawson does not identically disclose applicant's invention and the examiner has picked and chosen from different options in the reference. The examiner disagrees. Rawson shows the claimed structure that is used

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for a different purpose. The Federal Circuit has repeatedly established that a new use for an old device must be patented in the form of a method. See In re Schreiber, 42 USPQ2d 1429 (Fed. Cir. 1997)

Applicant has argued that Rawson is unrelated to the disclosure and claims. The examiner admits that Rawson is intended to be used for a different purpose, but notes that it is indeed related to the claims, as both the claims and Rawson disclose the same was of measuring body movements.

Applicant has further asserted that Rawson is incapable of measuring labor contractions, as labor contractions are relatively small movements and Rawson is only for measuring large body movements. Applicant's attention is directed to column 1, lines 59-61, where Rawson specifically discloses its use in measuring even small body movements.

Applicant has further asserted that Rawson is not adaptable to conform to the abdomen of a pregnant female. The examiner notes that the fact that a reference is silent on a feature does not mean that the feature is not present. Rawson has a cloth carrier that is flexible. Clearly, such a carrier is conformable to the abdomen.

Applicant has further argued that the output signal of Rawson is not communicated for monitoring contractions. The examiner disagrees, noting that Rawson teaches sending the output signal to monitor 34 for monitoring.

With respect to claim 41, applicant has argued that the limitation "in use" is inherent in the claim. The examiner disagrees, noting nothing limits that claim as applicant has indicated.

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Applicant has asserted that Rawson only discloses radio transmission and therefore not all of the possibilities recited by the term "wireless" transmission. Ignoring the fact that applicant does not have support for every type of wireless transmission, the examiner notes that the Federal Circuit has clearly established that a species (radio frequency transmission) anticipates a genus (wireless).

With respect to claim 36, applicant has asserted that the attachment means referred to in column 8 of Rawson are not for attaching the device to the body. The examiner directs applicant's attention to column 8, lines 40-41, where it clearly states that it has multiple means for attachment to the body.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
April 1, 2005

  
ROBERT L. NASSER  
PRIMARY EXAMINER